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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,307	01/23/2004	Shawn Poole	38763.1561	4625

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EXAMINER

MAYES, MELVIN C

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,307

Applicant(s)

POOLE ET AL.

Examiner

Melvin Curtis Mayes

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/04, 7/16/04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

(1)

The disclosure is objected to because of the following informalities: paragraph [0018] should refer to Figures 9A and 9B and reference to Figures 10 and 11 should be deleted from paragraph [0039].

Appropriate correction is required.

Claim Objections

(2)

Claims 30 and 31 are objected to because of the following informalities: the claims should depend from system claim 23 instead of method claim 22. Appropriate correction is required.

Claim Rejections - 35 USC § 112

(3)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(4)

Claims 9, 10, 20 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 9, 10, 20 and 30 contains the trademark/trade name Sato and DataMax. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a label printer and, accordingly, the identification/description is indefinite.

Double Patenting

(5)

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

(6)

Claims 17-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 14-23 of copending Application No. 10/845,244. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

(7)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(8)

Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/845,244.

Copending Application No. 10/845,244 claims a label application system comprising: a label printer; label applicator assembly; feed reel; take-up reel; liner take-up motor; clutch; and liner tension detector. The claims of the present application are fully encompassed by the claims of Copending Application No. 10/845,244.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

(9)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(10)

Claims 1, 2, 4-8, 13-15, 17-19, 23-27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Bernhard et al. 6,024,149.

Snyder et al. disclose a labeling machine having a constant tension driving system for labeling articles comprising: supply roll 16 of labels mounted on a spindle, printer 112; dispensing unit 18 with peeler bar for removing labels from the backing material; applicator 20 for applying labels to articles; driving and metering roll 114 for pulling the web from the supply roll; constant tensioning device 24 for maintaining constant tension in the web downstream of the driving and metering roll and downstream of the peel bar; and take-up drum 26 for waste backing material. The applicator may be any conventional applicator such as conventional vacuum blow applicator. The constant tensioning device may be a power dancer 108 with pivotable lever arm 118. Take-up drum is mounted on a shaft of a motor which operates to rotate the drum. The drum is intermittently operated depending on the position of the lever arm and the motor is activated by a limit switch (col. 5-9). Snyder et al. do not disclose providing the applicator with a head having an angled surface.

Bernhard et al. teach that in an air-blast labeling apparatus, the air-blast labeling device comprises a suction plate 16 and air blast unit having air blast plate 19 with air blast nozzles 20 and fine-meshed screen 26 to compensate for the effect of differences in the flow of air between individual blast nozzles, the air blast unit connected to a supply of compressed air and the supply of air controlled by a three-way solenoid valve. The labeling device and transport device are controlled with sensor elements. Bernhard et al. further teach that in an air-blast labeling apparatus, the air-blast device 2 includes a suction plate 16 having an inclined sliding surface 50 for the labels and provided with a plurality of elevations in the shape of saw teeth to allow the label to slide along the sliding surface and be deflected slightly downwards so that it travels at an acute angle to the suction plane beneath the suction plate. (col. 6, line 30 – col. 8, line 50).

It would have been obvious to one of ordinary skill in the art to have modified the method and machine of Snyder et al. for labeling articles by providing the vacuum blow applicator as an air blast device having suction plate and air blast unit having air blast plate and screen (air-directing manifold and baffle plate) and connected to a supply of compressed air controlled by a solenoid, as taught by Bernhard et al., as the parts of an air blast labeling device for applying labels.

It would have been obvious to one of ordinary skill in the art to have further modified the method and machine of Snyder et al. by providing the suction plate of the air blast device with an inclined sliding surface, as taught by Bernhard et al., to allow the label to slide along the sliding surface and be deflected slightly downwards so that it travels at an acute angle to the suction plane beneath the suction plate. By providing the suction plate with an inclined surface, the applicator head having an angled surface, as claimed, is obviously provided.

(11)

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Bernhard et al. 6,024,149 as applied to claim 2 above, and further in view of Marano 3,436,294.

Snyder et al. disclose that the take-up drum is mounted on a shaft of a motor which operates to rotate the drum intermittently.

Marano teaches that in a label dispensing and applying apparatus having a take-up spindle intermittently driven to wind up label depleted tape, a drive motor is intermittently energized by way of an electrically controlled clutch and brake assembly (col. 3, lines 68 – col. 4, line 7).

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It would have been obvious to one of ordinary skill in the art to have modified the machine of the references as combined for labeling by providing the motor for rotating the take-up drum with a clutch, as taught by Marano, to intermittently energize the drive motor. By providing a clutch to intermittently energize the motor for the take-up drum, a clutch restricting the drum (reel) to turn in only one direction, as claimed, is obviously provided.

(12)

Claims 9, 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Bernhard et al. 6,024,149 as applied to claim 1, 17 and 23 above, and further in view of O'Brien, Jr. 6,220,330.

Snyder et al. disclose that the printer is typically an "off-the-shelf" printer.

O'Brien, Jr. teaches that printing assembly that can be used to print labels include commercially available print engine available from Sato under Model No. 8485S. (col. 1, lines 1-7).

It would have been obvious to one of ordinary skill in the art to have modified the machine of the references as combined for labeling by providing the printer as a print engine available from Sato under Model No. 8485S, as taught by O'Brien, Jr., as a commercially available print assembly that can be used to print labels.

(13)

Claims 11, 12, 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Bernhard et al. 6,024,149 as applied to claims 1, 17 and 23 above, and further in view of Cleary et al. 3,682,743.

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Cleary et al. teach that in a labeling machine, the supply reel of labels is mounted between guide discs 100, 102, at least one of the discs provided with a collar and releasable locking handle to permit spacing between the discs to be varied to accommodate supply reels of varying width and allow easy removal of the disc for easy loading of a fresh roll of labels (col. 4, lines 20-42).

It would have been obvious to one of ordinary skill in the art to have modified the machine of the references as combined for labeling by providing the supply roll as mounted on the spindle between guide discs, one of which has a releasable locking handle, as taught by Cleary et al, to permit spacing between the discs to be varied to accommodate supply reels of varying width and allow easy removal of the disc for easy loading of a fresh roll of labels. By providing a guide disc with a releasable locking handle, a latch or latching means for holding the labels on the feed reel (spindle), as claimed, is obviously provided.

(14)

Claims 1, 2, 4-8, 17-19 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Allen 5,853,530.

Snyder et al. disclose a labeling machine having a constant tension driving system comprising: supply roll 16 of labels, printer 112; dispensing unit 18 with peeler bar for removing labels from the backing material; applicator 20 for applying labels to articles; driving and metering roll 114 for pulling the web from the supply roll; constant tensioning device 24 for maintaining constant tension in the web downstream of the driving and metering roll and downstream of the peel bar; and take-up drum 26 for waste backing material. The applicator may be any conventional applicator such as conventional vacuum blow applicator. The constant

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tensioning device may be a power dancer 108 with pivotable lever arm 118. Take-up drum is mounted on a shaft of a motor which operates to rotate the drum. The drum is intermittently operated depending on the position of the lever arm and the motor is activated by a limit switch (col. 5-9). Snyder et al. do not disclose providing the applicator with a head having an angled surface.

Allen teaches that a label receiver for a blow-method label applicator may be provided with a chamfered front end to facilitate the transfer of labels onto the receiving face and may be provided with a receiving face having a recess for securely fixing the label on the receiving face, the recess having chamfered edges for assisting in positioning of the label in the recess (col. 9, lines 10-25).

It would have been obvious to one of ordinary skill in the art to have further modified the method and machine of Snyder et al. for labeling articles by providing the vacuum blow applicator with a chamfered front end and/or a receiving face having a recess with chamfered edges, as taught by Allen, to facilitate the transfer of labels onto the receiving face or to securely fix the label on the receiving face, chamfered edges of the recess for assisting in positioning of the label in the recess. By providing the applicator with a chamfered front end and/or a receiving face with recess having chamfered edges, an applicator head having an angled surface, as claimed, is obviously provided.

(15)

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Allen 5,853,530 as applied to claim 2 above, and further in view of Marano 3,436,294.

Snyder et al. disclose that the take-up drum is mounted on a shaft of a motor which operates to rotate the drum intermittently.

Marano teaches that in a label dispensing and applying apparatus having a take-up spindle intermittently driven to wind up label depleted tape, a drive motor is intermittently energized by way of an electrically controlled clutch and brake assembly (col. 3, lines 68 – col. 4, line 7).

It would have been obvious to one of ordinary skill in the art to have modified the machine of the references as combined for labeling by providing the motor for rotating the take-up drum with a clutch, as taught by Marano, to intermittently energize the drive motor. By providing a clutch to intermittently energize the motor for the take-up drum, a clutch restricting the drum (reel) to turn in only one direction, as claimed, is obviously provided.

(16)

Claims 9, 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Allen 5,853,530 as applied to claim 1, 17 and 23 above, and further in view of O'Brien, Jr. 6,220,330.

O'Brien, Jr. teaches that printing assembly that can be used to print labels include commercially available print engine available from Sato under Model No. 8485S. (col. 1, lines 1-7).

It would have been obvious to one of ordinary skill in the art to have modified the machine of the references as combined for labeling by providing the printer as a print engine available from Sato under Model No. 8485S, as taught by O'Brien, Jr., as a commercially available print assembly that can be used to print labels.

(17)

Claims 11, 12, 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. 6,199,614 in view of Allen 5,853,530 as applied to claims 1, 17 and 23 above, and further in view of Cleary et al. 3,682,743.

Cleary et al. teach that in a labeling machine, the supply reel of labels is mounted between guide discs 100, 102, at least one of the discs provided with a collar and releasable locking handle to permit spacing between the discs to be varied to accommodate supply reels of varying width and allow easy removal of the disc for easy loading of a fresh roll of labels (col. 4, lines 20-42).

It would have been obvious to one of ordinary skill in the art to have modified the machine of the references as combined for labeling by providing the supply roll as mounted on the spindle between guide discs, one of which has a releasable locking handle, as taught by Cleary et al, to permit spacing between the discs to be varied to accommodate supply reels of varying width and allow easy removal of the disc for easy loading of a fresh roll of labels. By providing a guide disc with a releasable locking handle, a latch or latching means for holding the labels on the feed reel (spindle), as claimed, is obviously provided.

Conclusion

(18)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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(19)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234.

The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
April 8, 2005